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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/426,573	10/25/1999	ALAN S. FISHER	20425.00510	2067

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EXAMINER

PATEL, JAGDISH

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 04/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/426,573

Applicant(s)

FISHER ET AL.

Examiner

JAGDISH N PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 15-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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### DETAILED ACTION

1. This communication is in response to amendment filed 2/6/03.

#### *Response to Amendment*

2. Claims 15, 20 and 23 have been amended.

#### *Response to Arguments*

3. Applicant's arguments filed 2/6/03 have been fully considered but they are not persuasive.

The applicant citing prior art Jones et al. (col. 6 lines 64- col. 7, line 32) argued that claim 15 as amended does not teach "retrieving said status information from the common carrier information system". The Examiner disagrees with this interpretation of the Jones reference by the applicant.

Jones teaches storage means for storing a **status information** relating to a commerce-related event (this limitation is disclosed by Jones as financial information regarding the potential borrower from the **data file of stored financial information** in credit bureau data processing system at block 52, Fig. 2 block 52 and described at col. 5 L 66- col. 6 L 5). This status information is accessed and retrieved by data processor 5 of Jones (access an open line to the credit bureau system, col. 6 L 5-11). This status information used subsequently to extract actual status of the ("approved",

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"rejected", "not determined" see Figure 2) commerce related event (financial information regarding the potential borrower, col. 5 L 66- col. 6 L 5).

The newly amended limitation "common carrier information system" is not afforded patentable weight since this element has no relationship to other structural means of the processing and transmission system. In other words the "common carrier information system" is not structurally related to other components (i.e. the common carrier information system is not linked with the storage means, retrieval means etc.) of the claimed system.

Similar analysis is also applicable to method claim 20.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 15-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 15 recites "said status information" in line 2.

This limitation lack antecedent basis in the claim.

Claim 15 recites in lines 3-4 "from the common carrier information system. This limitation lack antecedent basis in the claim.

Claim 15 recites "storage means" for storing a status information in line 2 and subsequently recites "status information retrieval means" also for storing the status information in the storage means. This duplicate recitation of storing function attributed to two different means renders the claim indefiniteness.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

6. Claims 15, 18-20, 23 and 24 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Jones et al (US Pat. 5,797,133, effective filing date Aug. 31, 1994) (hereafter referred to as Jones).

Claims 15 and 20. Jones discloses an update processing and transmission system and method (automatically determining the approval status of a potential borrower, abstract):

storage means, for storing (said) status information relating to a commerce-related event (the (approval) status ... are stored on the hard drive of the data processor 5 at

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block 68 col. 6 L 30-49, Note: commerce-related event is loan processing by the data processor, status information is credit worthiness information about a borrower);

status information retrieval means for retrieving said status information from a common carrier information system and storing the status in the storage means(at steps 78, 80 and 70 shown in Fig. 2 and explained in col. 6 L 64- col. 7 L 37 in detail, processor retrieves the stored approval status, merges with a form letter, in order to create a notice letter);

message generation means for automatically generating a status message reflective of said status information (..creates a notice letter with appropriate wording.. describe the borrower's approval status, col. 6 L 64 - col. 7 L 8 );

message forwarding means for automatically forwarding said status message to a point where it may be accessed by an interested party (the notice letter is then automatically sent to the dealer blocks 78 and 80 Fig. 2, col. 7 L 9-13).

7. Claim 18, 19, 23 and 24. Status information is stored ..database within a first computer and ..separately storing database (Jones, col. 6 and 7 as discussed above in claim 1 analysis) .

### ***Claim Rejections - 35 USC § 103***

9. Claims 16, 17 and 21, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jones et al.

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Claims 16 and 21 Jones fails to teach that the status information relates to shipment of an item. However, the inventive concept disclosed by Jones, would be equally applicable to any consumer/business interaction where a need for automatically informing status of a commercial activity exists (e.g. ordering furniture at a department store with a predetermined delivery date/time and if there is a change in the status of the delivery date/time). In other words, storing status of a commercial activity and automatically generating a message reflective of the status information and automatically forwarding the message where the message may be accessed by an interested party as disclosed by Jones is also applicable to shipment of an item since no distinct features are recited in the claims 16 and 21 and their respective parent claim that separates loan status versus shipment status in that both activities pertain to a commerce related event.

10. Claims 17 and 22 recite components first computer and second computer, which in combination perform same function as processor 5 of the Jones system. Courts have held that making component separable that perform different functionality is common knowledge in the art (In re Dulberg, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961). In the instant claim(s) the reference teaches both elements (status information retrieval means and means that stores the status information database are contained in same processor 5, as discussed previously, col. 6 and 7). Since separating multiple functions performed by a computer into one or more computer to suite a desired application and business environment is a common knowledge in view of the cited court ruling, it would have been obvious to one of ordinary skill in the art at the time of invention to

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separate the retrieval means and the storage means for variety of reasons for example in a manner that the credit bureau provides credit analysis to many institutions who employ services of the credit bureau to check credit worthiness of their customers applying for credit. In this arrangement (a computer operated by) the credit bureau transmits (via a communication network) the status report regarding the credit application (approval or disapproval) to the (computer operated by) financial institution that in turn communicates to the customer.

#### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,



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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

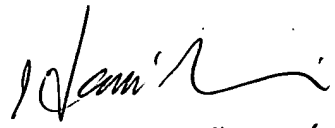
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jagdish Patel whose telephone number is (703) 308-7837. The examiner can normally be reached Monday-Thursday from 8:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin, can be reached at (703) 308-1038. The fax number for Formal or Official faxes to Technology Center 3600 is (703) 305-7687. **Draft faxes may be submitted directly to the examiner at (703) 746-5563.**

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 308-1114. Address for hand delivery is 2451 Crystal Drive, Crystal Park 5, 7<sup>th</sup> Floor, Alexandria VA 22202.

JNP 4/15/03

  
**HANI M. KAZIMI**  
**PRIMARY EXAMINER**